



Application No.10/567,631

Nationalization of PCT/EP2004/051702

Attorney Docket No. WSP242US

Response to Restriction Requirement dated January 5, 2009

Date: April 14, 2009

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Matter of United States Patent Application:

Applicant(s): Gabriel Blume et al.

Examiner: Jennifer Ann Berrios

Application No.: 10/567,631

Art Unit: 4121

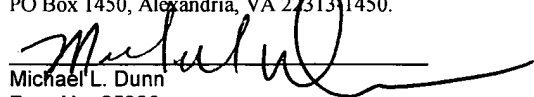
Filed: February 8, 2006

For: COSMETIC COMPOSITION  
PROMOTING OXYGEN  
TRANSPORT INTO THE SKIN

Confirmation Number: 1303

**Certificate of Mailing by First Class Mail**

I certify that this Response to Restriction Requirement is being deposited on April 14, 2009 with sufficient postage with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 and is addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

  
Michael L. Dunn  
Reg. No. 25330

### RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Honorable Sir:

This is in reply to the official action of January 5, 2009 requiring an election between four species.

In view of telephone interviews with the Examiner to clarify what is intended by the Examiner in the species election, the Applicants elect;

- 1) specific lipid conjugate galactocerebrosides specifically mentioned in claim 15 and claims 13, 14, and 18-36 generic thereto.
- 2) lipid conjugate solvent jojoba oil specifically mentioned in claim 23 and claims 13 – 22 and claims 24-35 generic thereto.
- 3) specific nicotinic compound nicotinic acid specifically mentioned in claim 27 and

claims 1-26 and 28-35 generic thereto.

4) specific alcohol is glycerin specifically mentioned in claims 29 and 36 and claims 13-28 and 32-36 generic thereto.

In all cases above, it is clear that the named generic claims do not exclude the elected species and are thus generic thereto. In the event that the Examiner refuses to accept the generic claims listed by the applicant, the Applicant elects 1) claims 13-17, 23, 33, and 36; 2) 21-25 and 33-36; 3) claims 26-27 and 4) 28-31, 33 and 36 with traverse on the ground that the Examiner's list of generic claims for the elected species are incomplete and inaccurate.

FURTHER ALL ELECTIONS HEREIN ARE MADE WITH TRAVERSE.

At the outset the requirement seems confusing by mixing U.S. and PCT practice.

All that is needed in PCT Practice is unity of invention.

37 CFR 1.475 says:

“(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”

All claims of the present invention has the special technical feature of “ **A cosmetic composition to assist oxygen transport into the skin with vesicles as carriers, wherein the composition comprises ...lipid ... and ...a fluorocarbon or mixture of fluorocarbons charged with oxygen.**”

The Examiner is referred to MPEP 1850 I.

“....In applying **PCT Rule 13.2** to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under **35 U.S.C. 371**, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for

searching and/or preliminary examination, claims to the categories which meet the requirements of **PCT Rule 13.2**....

The categories of invention in former PCT Rule **13.2** have been replaced with a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Chapter 10 of the International Search and Preliminary Examination Guidelines also contains examples concerning unity of invention...."

The Examiner is also referred to MPEP 1850 II:

" ....From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. However, the International Searching Authority or the International Preliminary Examining Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the international search to certain classification groups.... If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention...."

Election of species is a U.S. practice and has no place in PCT practice as applied to the present application where, as here, there is no reasonable basis for application of prior art to generic claims.

The Examiner has cited U.S. Patents 6,022,561; 3,645,390; and 3,890,333. None of these patents, alone or together, address the "special technical features" of the present claims under either 35 U.S.C. 102 or 35 U.S.C. 103.

The references cited by the Examiner merely individually address different possible components of the presently claimed cosmetic composition and none of the cited patents even mention "fluorinated hydrocarbon" for any purpose and certainly do not disclose or suggest "fluorinated hydrocarbon" in such a composition, which is at the heart of the oxygen carrying

portion of the presently claimed **cosmetic composition to assist oxygen transport into the skin.**

The present claims are clearly united by a special technical feature and have “unity of invention” under PCT Rules.

The claims may thus not be restricted from each other.

The mere addition of additional components, i.e. “lipid conjugate solvent”, “nicotinic compound” and/or “alcohol”, in subclaims, does not remove “lipid conjugate” from the claims in which additional components are added.

MPEP 1850 B Markush Practice states:

**“B. "Markush Practice"**

The situation involving the so-called Markush practice wherein a single claim defines alternatives (chemical or non-chemical) is also governed by **PCT Rule 13.2**. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in **PCT Rule 13.2**, shall be considered to be met when the alternatives are of a similar nature.

When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) All alternatives have a common property or activity; and

(B)

(1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(B)

(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

In paragraph (B)(1), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the

common property or activity. The structural element may be a single component or a combination of individual components linked together.

In paragraph (B)(2), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

The fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention should be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised. (See Examples in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the Patent Examiner's Toolkit link or from WIPO's web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm)))."

CLEARLY IN THE PRESENT CASE, ALL ALTERNATIVES IN THE PRESENT CLAIMS HAVE PROPERTIES IN COMMON AND THERE SHOULD THEREFORE BE NO ELECTION BETWEEN THEM UNDER (A) ABOVE.

IN THE CASE OF "ONE MARKUSH ALTERNATIVE NOT BEING NOVEL OVER THE PRIOR ART" IN THE LAST MPEP FINAL PARAGRAPH ABOVE, IT IS CLEAR THAT WHAT IS BEING REFERRED TO IS THE CLAIM NOT THE MARKUSH ELEMENT. OTHERWISE, ELECTION OF SPECIES WOULD BE REQUIRED EXCEPT IN THE UNUSUAL CASE WHERE ALL MEMBERS OF THE MARKUSH GROUP WERE INDEPENDENTLY NOVEL REGARDLESS OF THE NOVELTY OF THE CLAIM.



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The restriction should therefore be withdrawn for two major reasons, i.e. a) there is unity of invention and b) even if there weren't unity of invention, all claims read on species (1).

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Michael L. Dunn", followed by a long horizontal line.

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MLD/mjk